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Application No. 10/633,919
Amendment dated December 26, 2006
Reply to Office Action of June 26, 2006

REMARKS

Applicant amended claim 1, and added new claims 23-26 to further define Applicant's invention.

In the Office Action, the Examiner rejected claims 6-16, 21, and 22 under 35 U.S.C. § 112, first paragraph, as failing to reasonably provide enablement for all precipitation hardenable alloys, while being enabling for a core rod made of the precipitation hardenable alloy composition recited in claim 7. The Examiner further asserted that claims 6 through 15 encompass casting any and all metal alloys, while the specification disclosed only beryllium-cooper alloys. The Examiner advised that Applicant could overcome both rejections by incorporating the recitations of dependent claims 7 and 16 into independent claim 1.

Applicant submits that claim 6 is allowable over the 35 U.S.C. § 112, first paragraph, rejection without including the recitations of claim 7. Applicant respectfully submits that one of ordinary skill in the art would recognize that the Applicant was in possession of the necessary common attributes of "a precipitation-hardenable alloy core rod" used to produce "a non-ferrous metal casting having a core and a uniform sidewall thickness having a deviation in the thickness in a range of +/- 0.060 inches" such that Applicant possessed the members of the genus of precipitation-hardenable alloy core rods in view of the disclosed species of precipitation-hardenable alloy core rods. Applicant identified the problem of core rods that change shape during the method of forming a core within a metal casting and the resulting problems with such castings. Applicant provided functional recitations in the specification regarding the precipitation-hardenable alloy core rod. By way of example, the precipitation-hardenable alloy core rod does not stress relax during and after the pouring step, or it remains straight during and after the pouring step, or it does not bend during and after the pouring step sufficient to produce the claimed metal casting.

Applicant submits that claim 6 is allowable over the 35 U.S.C. § 112, first paragraph, rejection without including the recitations of claim 16. To expedite the

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prosecution of the application, Applicant has amended claim 6 to recite "pouring molten non-ferrous metal into the mold and around the sand core with core rod; and producing a non-ferrous metal casting." While Applicant disclosed a preferred embodiment of the claimed method that included pouring a beryllium-copper alloy casting, one of ordinary skill in the art would recognize from Applicant's specification that the Applicant was in possession of a method of producing improved castings that were not limited to producing a beryllium-copper alloy casting. Applicant identified the problem of core rods that change shape during the method of forming a core within a metal casting and the resulting problems with such castings. Applicant submits that claim 6, as amended, is supported by the specification and overcomes the Examiner's 35 U.S.C. § 112, first paragraph, rejection.

The Examiner rejected claims 6-16, 21, and 22 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 6 to overcome the 35 U.S.C. § 112, second paragraph.

Applicant submits that independent claim 6 is patentable and that dependent claims 7-16 and 21-26 dependent from independent claim 6, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including

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any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1068.

Respectfully submitted,

MARTIN & FERRARO, LLP

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By: Thomas H. Martin

Thomas H. Martin
Registration No. 34,383

1557 Lake O'Pines Street, NE
Hartville, Ohio 44632
Telephone: (330) 877-0700
Facsimile: (330) 877-2030